

PATENT
Attorney Docket No. 02814.0080

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Kevin Blann et al.) Group Art Unit: 1796
)
Application No.: 10/539,517) Examiner: C. Caixia Lu
)
Filed: April 5, 2006)
)
For: Tetramerization of Olefins) Confirmation No.: 4811

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR WITHDRAWAL OF FINAL OFFICE ACTION

In the Office Action of April 17, 2008, the Examiner withdrew all prior art rejections of the claims and only rejected the claims under 35 U.S.C. §112, second paragraph.

On May 12, 2008 Applicants filed a Reply amending the claims to avoid the §112 rejections. The Reply specifically stated that it was a “reply to the Office Action mailed April 17, 2008.”

However, while not known to Applicants at the time, the Examiner had withdrawn the Office Action of April 17, 2008 in an Office Action mailed May 2, 2008. In that Office Action the Examiner rejected certain of Applicants’ claims under 35 U.S.C. §102(b) for being anticipated by Wass (WO 01/10876). While the Examiner referred to an Office Action mailed on “April 16, 2008” being withdrawn, actually it was mailed on April 17,

2008. In any event, this rejection based on Wass was a new ground of rejection of the claims.

The undersigned was not aware the Office Action of May 2, 2008 had been issued when the Reply of May 12, 2008 was filed, so no response had been made with respect to the rejection based on Wass. Nor had the Examiner phoned the undersigned and told him the Action of April 17 had been withdrawn at the time of issuance of the May 2, 2008 Office Action. If so, no Reply would have been filed to the Office Action of April 17.

On July 14, 2008, the Examiner issued a further Office Action, indicating that the §112, second paragraph rejection had been overcome by the Reply filed May 12, 2008, but since Applicants did not traverse the §102 rejection based on Wass, the rejection was maintained and the rejection was made final.

However, as noted above, no traversal was made of the §102 rejection in the Reply filed May 12, 2008 because the undersigned was not aware of it at the time. Subsequently and after becoming aware of the May 2 Office Action, Applicants were intending to reply to the §102 rejection by August 2, 2008. However, that date became moot as a result of the issuance of the Office Action of July 14, 2008.

Applicants are not objecting to the issuance of the further Office Action of July 14, 2008, but it is believed to be unfair to make it a final rejection because Applicants were never given the opportunity to reply to the §102 rejection. While the Examiner took the Reply filed May 12, 2008 as a Reply to the Office Action of May 2, 2008, it is believed this is also unfair because it clearly stated that it was a Reply to the "Office Action of April 17, 2008."

The rejection based on Wass is a new ground of rejection and Applicants were not given a chance to respond to it before issuance of the final Office Action of July 14, 2008. M.P.E.P. §706.07(a) clearly provides as follows:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement Furthermore, a second or any subsequent action on the merits in any application . . . will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement . . . of any claim not amended by applicant . . . in spite of the fact that other claims may have been amended to require newly cited art.

Under the requirement of §706.07(a) it is believed Applicants should be given the opportunity to fully respond to the §102 rejection of May 2, 2008, as repeated in the Office Action of July 14, 2008, and the newly cited reference to Wass without being restricted by the requirements of Rule 116.

Accordingly, withdrawal of the finality of the Office Action of July 14, 2008 is requested.

If there is any fee due in connection with the filing of this Request, please charge such fee to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
Arthur S. Garrett
Reg. No. 20,338
(202) 408-4091

Dated: August 7, 2008